

Application No.: 10/777,902

Docket No. 10017912-3 (1509-239A)

REMARKS

Applicants note the indication of claims 6, 12, 13, 20, 22 and 26-30 containing allowable subject matter.

Claim 26 has been amended to overcome the objections to it. Entry of the amendment is in order because it does not require substantive consideration of the claims, nor does it require a new search. The sole purpose of the amendment is to cure an objection to claim 26. Obviously, the Examiner was able to understand claim 26, without the changes being made by the present amendment.

Applicants traverse the rejection of claims 1, 3, 4, 8, 9, 11, 14 and 22-24 as being anticipated by Ohnishi, USP 5,633,600.

Independent claim 1, upon which claims 3, 4, 8, 9, 11 and 14 depend, distinguishes over Ohnishi by requiring the capacitor to be switched from the initial finite capacitance value to a substantially open circuit. This limitation is not considered in the Office Action and is not included in the conventional capacitors of Ohnishi. Because this feature is not considered in the Office Action, the Office Action does not attempt to establish a prima facie case of anticipation with regard to claim 1.

Further, if the Examiner is relying on inherency with regard to the requirement of claim 1 for the capacitor to be switched from the finite capacitance value to a substantially open circuit, no attempt has been made to establish inherency. The fact that a certain result or characteristic *may* occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993); *In re Oelrich*, 666 F.2d 578, 581-82, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981). To establish inherency, extrinsic evidence

Application No.: 10/777,902

Docket No. 10017912-3 (1509-239A)

must make clear that the missing descriptive matter is *necessarily* present in the thing described in the reference and that it would be so recognized by persons of ordinary skill in the art. Inherency may not be established by possibilities or probabilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *In re Roberston*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999). In relying upon a theory of inherency, the Examiner must provide a basis in fact or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the prior art. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (B.P.A.I. 1990). Because the Examiner has made no attempt to satisfy the burden of proving the conventional capacitors of Ohnishi switch from a finite capacitance value to a substantially open circuit, the rejection of claim 1 is wrong.

The Examiner's interpretation of the word "switchable" in connection with claim 1 is incorrect. "Switchable" in claim 1 refers to a capacitor that is switched from a finite capacitance state to a substantially open circuit. Thus, the word "switchable" in claim 1 does not refer to a capacitor that goes from a charge to a discharge state. Virtually all capacitors are capable of going from a charge to a discharge state.

Because claim 1 is not anticipated by Ohnishi, claims 3, 4, 8, 9, 11 or 14 are not anticipated.

Based on the above, Ohnishi does not disclose a switchable capacitor as connected between a control electrode and a DC power supply terminal, as claim 3 requires. Ohnishi does not disclose the claim 4 requirement for a resistive element to supply current to at least one switchable capacitor because Ohnishi fails to disclose a switchable capacitor. Likewise, Ohnishi does not disclose the claim 8 requirement for a

Application No.: 10/777,902

Docket No. 10017912-3 (1509-239A)

switchable capacitor that includes first and second voltage controlled switchable capacitors respectively connected to delay coupling of transitions of control electrodes of the first and second transistors.

Ohnishi also fails to disclose the claim 9 requirement for a first capacitor arranged to have a finite capacitance value on a first side of a voltage threshold and a substantially open circuit on a second side of the first voltage threshold, nor does Ohnishi disclose the claim 9 requirement for the second capacitor to be arranged to have a finite capacitance value on a second side of a second voltage threshold and a substantially open circuit on a first side of the second threshold.

With regard to independent claim 22, Ohnishi fails to disclose first and second capacitors that are switched off, as required by these claims. In Ohnishi, the capacitors are conventional capacitors that are charged and discharged in a conventional manner.

The allegation in the Office Action that a capacitor that is switched off is interpreted as a capacitor that is discharged and a capacitor that is switched on is interpreted as a capacitor that is charged is completely wrong. A capacitor, while it is being discharged, supplies current to the circuitry with which it is connected and thus is switched on. Similarly, a capacitor that is being charged, receives current from the circuit to which it is connected and is also switched on. The Examiner's interpretation of the words "switched on" and "switched off" is without foundation. The Examiner is required to supply evidence to support his position that the words "switched on" and "switched off," in connection with a capacitor are synonymous with a capacitor being charged and discharged.

Application No.: 10/777,902

Docket No. 10017912-3 (1509-239A)

Claim 24, which depends upon claim 22, specifically indicates the first and second capacitors are charged and switched off. Hence, the language of claim 24 emphasizes the aforementioned distinction between charging and switching of capacitors.

The rejection of claims 15-19 as being obvious as a result of Ohnishi in view of Wanlass, USP 3,356,858, and Vikinski, USP 6,150,862, is traversed. The secondary references fail to cure the above noted deficiencies of the claims upon which claims 15-19 depend.

In view of the foregoing amendments and remarks, allowance is in order.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 08-2025 and please credit any excess fees to such deposit account.

Respectfully submitted,

Kenneth KOCH II et al.



Allan M. Lowe
Registration No. 19,641

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400
Telephone: 703-684-1111
Facsimile: 970-898-0640
Date: May 11, 2007
AML/tal/cjf